



Keynote Speaker:

Maren Christensen,

Executive Vice President &
General Counsel, Universal Studios

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The Intellectual Property Section of the State Bar of California presents the



31ST ANNUAL INTELLECTUAL PROPERTY INSTITUTE

November 3-4, 2006

Bonus Session: Nuts & Bolts Programs on November 2, 2006

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The State Bar of California and the Intellectual Property Section of the State Bar of California are approved MCLE Providers.



Thursday, November 2, 2006

TRACK I – Patent	TRACK II – Trademark	TRACK III – Copyright
Nuts and Bolts of Patent Prosecution, Licensing and Litigation	Nuts and Bolts of Trademark Prosecution, Licensing and Litigation	Nuts and Bolts of Copyright Licensing and Litigation

Friday, November 3, 2006

TRACK I - Patents	TRACK II - Mixed
Yours, Mine and Ours: The Shaping of Our Nation's Cultural Policy by Competing Intellectual Property Ideologies	
Prosecuting and Defending Antitrust Counterclaims in Patent Infringement Suits	Copyright Year in Review
IP Perspectives from the Bench – Markman Hearings	Best Practices in IP Licensing
 Luncheon & Keynote Presentation: Maren Christensen, Executive Vice President and General Counsel of Universal Studios	
Update on Patent Reform Legislation and Regulations	IP Perspectives from the Bench—Trademark, Copyright and Trade Secret Issues
Patent Defeating Activities	Foreign Trademark Protection—Why? Where? How? and What's New?
Achieving Diversity: Hiring and Retention Practices	

Saturday, November 4, 2006

TRACK I - Patents	TRACK II - Mixed
Patent Year in Review	IP and Licensing Issues in Acquisitions: Beyond Due Diligence
Thinking Outside The Box — A Case Study for Defeating the Patent Trolls	Trademark Year in Review
In the Wake of <i>Phillips v. AWH</i> : The Aftermath and a Debate Over <i>DeNovo</i> Appellate Review	The Medium is the Message: How New Media Technologies Will Transform Copyright Protection and Limits
Sex, Drugs and Rock & Roll—A Short Primer on Substance Abuse	

THURSDAY, NOVEMBER 2, 2006

9:00a.m. – 1:00p.m.
Executive Committee Meeting

2:00p.m. – 5:00p.m. (3 Hours MCLE Credit)
Concurrent Sessions (includes 15 minute break)
TRACK I – PATENTS

Nuts and Bolts of Patent Prosecution, Licensing and Litigation Practice
Attorneys experienced in this field drawn from the IP Section Executive Committee and Institute Faculty will present a program on the basics of patent prosecution and litigation practice designed for new admittees, practitioners new to the field of law, and paralegals.

Panelists: *D. Ben Borson, Fliesler Meyer LLP (San Francisco)*
Kevin DeBré, Stubbs Alderton & Markiles, LLP (Sherman Oaks)
R. Dabney Eastham, Ladas & Parry LLP (Los Angeles)
Tamara Frazier, Fish & Richardson, (Redwood City)
Randall E. Kay, DLA Piper Rudnick Gray Cary (San Diego)
Tejinder “TJ” Singh, Klein O’Neill & Singh LLP (Irvine)

TRACK II – TRADEMARKS
Nuts and Bolts of Trademark Prosecution, Licensing and Litigation
Attorneys experienced in this field drawn from the IP Section Executive Committee and Institute Faculty will present a program on the basics of trademark prosecution and litigation practice designed for new admittees, practitioners new to the field of law, and paralegals.

Panelists: *Kevin DeBré, Stubbs Alderton & Markiles, LLP (Sherman Oaks)*
Gregory M. Krakeau, Fish & Richardson (San Diego)
John A. Mizhir, Jr., Fish & Richardson (San Diego)

Track III – COPYRIGHTS
Nuts and Bolts of Copyright Prosecution and Litigation
Attorneys experienced in this field drawn from the IP Section Executive Committee and Institute Faculty will present a program on the basics of trademark prosecution and litigation practice designed for new admittees, practitioners new to the field of law, and paralegals.

Panelists: *Kevin DeBré, Stubbs Alderton & Markiles, LLP (Sherman Oaks)*
Jed Scully, Professor of Law & Director, Intellectual Property Program, McGeorge School of Law; UOP (Sacramento)
Neil A. Smith, Sheppard Mullin Richter & Hampton LLP (San Francisco)
Cydney A. Tune, Pillsbury Winthrop LLP (San Francisco)

7:00p.m. – 10:00p.m.
Annual Executive Committee Alumni and Speaker’s Reception & Dinner

FRIDAY, NOVEMBER 3, 2006

7:00a.m. – 7:45a.m.
Continental Breakfast & Conference Registration

7:45a.m. – 8:00a.m.
Opening Remarks

8:00a.m. – 9:30a.m. (1.5 Hour MCLE Credit)
GENERAL SESSION
Yours, Mine and Ours: The Shaping of Our Nation’s Cultural Policy by Competing Intellectual Property Ideologies
Peter Jaszi, a Professor at Washington College of Law, American University (Washington, D.C.), a cultural historian of intellectual property and an activist for users’ rights, will discuss how since 1976 a once-stable consensus about the goals of copyright has degenerated into a stark (and sometimes ugly) contest among ideologies. Prof. Jaszi will discuss the two predominant competing visions of today and suggest a “third way” that may be open for lawyers, judges and legislators who care about how intellectual property doctrines shape national cultural policy.

Speaker: *Professor of Law Peter Jaszi, American University, Washington College of Law (Washington, D.C.)*

9:30a.m. – 9:45a.m.
Break

9:45a.m. – 11:00a.m. (1.25 Hour MCLE Credit)
TRACK I – PATENTS

Prosecuting and Defending Antitrust Counterclaims in Patent Infringement Suits
The interface of patent and antitrust law has become more complex as more and more patents are registered and as the antitrust authorities look more closely at the market effect of intellectual property rights. This program will focus on three areas of concern to both patent and antitrust lawyers. First, under what conditions will settlement of patent litigation be considered anticompetitive and evoke the attention of the antitrust authorities? Second, when are patent claims subject to antitrust counterclaims—are “fraud on the patent office” and “objectively baseless” the only attacks that may be made? And, third, after *Independent Ink*, how will a patent’s market power be ascertained?

Panelists: *Carole Handler, Foley & Lardner LLP (Los Angeles)*
Kent Bernard, Pfizer, Inc. (New York, NY)

TRACK II – MIXED
Copyright Year in Review
The panelists, well-known professors and experts in the field of copyright law, will be presenting an overview of the recent developments in copyright law and the foreseeable impact of these developments.
Moderator: *James Nguyen, Foley & Lardner LLP (Los Angeles)*
Panelists: *Neil Netanel, Professor of Law; UCLA School of Law (Los Angeles)*
Robert C. Lind, Professor of Law; Southwestern School of Law (Los Angeles)

11:00a.m. – 12:00noon (1 Hour MCLE Credit)
TRACK I – PATENTS
IP Perspectives from the Bench—Markman Hearings
Two California U.S. District Court judges are joined by a Texas U.S. District Court judge to discuss some of the complex issues that arise in *Markman* hearings. Hear directly from the bench about the approaches that were helpful in crystallizing issues and making the technology understandable. The discussion will be guided by David Barkan, an experienced patent litigator and frequent *Markman* hearing participant.

Moderator: *David Barkan, Fish & Richardson (Redwood City)*
Panelists: *Hon. Marilyn Huff, U.S. District Court of the Southern District of California (San Diego)*
Hon. Jeremy Fogel, U.S. District Court of the Northern District of California (San Jose)
Hon. Lee Yeakel, U.S. District Court (Austin, TX)

TRACK II cont. on next page

11:00a.m. – 12:00noon (1 Hour MCLE Credit) cont.

TRACK II – MIXED

Best Practices in IP Licensing

More advanced than the licensing discussion during the Nuts & Bolts Program, this is a follow up on more advanced issues. During this program the panel will discuss an overview of applicable intellectual property law as well as what is a license and how does it differ from other kinds of transfers. Issues of how licensors and licensees deal with liability exposure in licenses will be addressed along with similar issues that arise in drafting, negotiating and managing IP licenses.

Panelists: *Martin Fern, Silver & Freedman, APLC (Los Angeles)*
Karen Ballack, Weil, Gotshal & Manges LLP (Redwood Shores)

12:00noon. – 1:30p.m. (1 Hour MCLE Credit)



Luncheon & Keynote Program

Maren Christensen is Executive Vice President and General Counsel of Universal Studios. As such, she is responsible for the legal operations and oversight of lawyers for all businesses worldwide within the studio and the theme parks.

Maren is also Senior Intellectual Property Counsel for all NBC Universal businesses. She manages intellectual property policy issues worldwide and works closely with the Company's public policy executives advising on U.S. and foreign legislation, regulation and treaties. A growing focus of her practice is advising on new digital business models and anti-piracy.

A graduate of the University of Southern California Law Center, Maren was a partner at the law firm of Rosenfeld, Meyer and Susman in Beverly Hills where she specialized in intellectual property litigation prior to joining Universal in 1997. She has served as president of the L.A. Copyright Society and as a member of the Intellectual Property Section of the California State Bar and the Copyright Society of the United States. She speaks frequently on intellectual property issues.

"An excellent, funny, insightful public speaker, and an expert in I.P. law and strategy."—Bob Lambert, Senior Vice President, Worldwide Technology Strategy, The Walt Disney Company

Keynote Speaker: *Maren Christensen, Executive Vice President and General Counsel, Universal Studios (University City)*

1:30p.m. – 1:45p.m.

Break

1:45p.m. – 2:45p.m. (1 Hour MCLE Credit)

TRACK I – PATENTS

Update on Patent Reform Legislation and Regulations For the last couple of years Congress has been studying several different problems with the existing patent system as well as several alternative solutions to reform it. This program will review the current status of the reform efforts being undertaken by Congress and discuss the likely implications of the proposed reforms.

Panelists: *John Benassi, Heller Ehrman LLP (San Diego)*
Katherine Lutton, Fish & Richardson (Redwood City)

TRACK II – MIXED

IP Perspectives from the Bench—Trademark, Copyright and Trade Secret Issues

A panel of experienced federal judges will be presenting selected topics related to issues surrounding trademark, copyright and trade secret cases.

Moderator: *Naomi Gray, Paul Hastings Janofsky & Walker, LLP (San Francisco)*

Panelists: *Hon William J. Elfvig, Santa Clara County Superior Court (San Jose)*
Hon. Loretta A. Preska, U.S. District Court Southern District of New York (New York, NY)

2:45p.m. – 3:45p.m. (1 Hour MCLE Credit)

TRACK I – PATENTS

Patent Defeating Activities

In today's fiercely competitive economic environment, early market entry and accelerated commercialization of products and services are critical to the success of companies. However, zealous marketing activities and commercialization without proper intellectual property planning can jeopardize a company's ability to obtain intellectual property protection. To effectively protect intellectual property assets, the panelist—experienced patent lawyers—will discuss what constitutes patent-defeating activities and how to avoid them while still achieving business goals. The current state of the law relating to patent-defeating activities will be presented.

Panelists: *Mark Itri, McDermott Will & Emery (Irvine)*
Karen Laub, McDermott Will & Emery (Irvine)

TRACK II – MIXED

Foreign Trademark Protection—Why? Where? How? And What's New?

The panelists—attorneys with extensive foreign and domestic trademark experience for clients big and small—will cover issues such as why it is increasingly important to register trademarks abroad, where to seek foreign registrations, latest foreign searching/clearance options, strategies for initiating foreign applications (e.g., national, EU, Madrid), and new developments in foreign trademark protection.

Panelists: *Robert Burlingame, Pillsbury Winthrop Shaw & Pittman LLP (San Francisco)*
Patricia Cotton, Pillsbury Winthrop Shaw & Pittman LLP (Palo Alto)

3:45p.m. – 4:00p.m.

Break

4:00p.m. – 5:00p.m. (1 hour Elimination of Bias in the Legal Profession Credit)

GENERAL SESSION

Achieving Diversity: Hiring and Retention Practices

The panelists, an accomplished intellectual property litigator who serves as Chair of the California State Bar Diversity Coalition and a legal recruiter with expertise in diversity issues, will discuss successful strategies for recruiting and retaining a diverse workforce.

Panelists: *Craig Holden, Robins Kaplan Miller & Ciresi LLP (Los Angeles)*
Anna Marie Armstrong, Mlegal Consulting, Inc. (San Francisco)

6:00p.m. – 9:00p.m.

Wine-Tasting Reception & Dinner

SATURDAY, NOVEMBER 4, 2006

7:30a.m. – 8:00a.m.

Continental Breakfast & Conference Registration

8:00a.m. – 8:15a.m.

Opening Remarks

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8:15a.m. – 9:15a.m. (1 Hour MCLE Credit)

TRACK I – PATENTS

Patent Year in Review

The panelists, well-known experts in the field of patent law, will be presenting an overview of the recent developments in patent law and the foreseeable impact of these developments.

Panelists: *Matthew Weil, McDermott Will & Emery (Irvine)*

John Farrell, Fish & Richardson (Redwood City)

TRACK II – MIXED

IP and Licennsing Issues in Acquisitions: Beyond Due Diligence

Most lawyers know the importance of due diligence in acquisitions, but identifying potential deal-breaker issues is only half the story. Resolving these issues often requires creativity under extremely tight time constraints. Our panel members will discuss their experience in successfully overcoming IP obstacles to closing acquisitions by, for example, effectively obtaining third party consents, negotiating transition services agreements, structuring IP sharing relationships and setting up technology escrow arrangements.

Panelists: *Kevin DeBré, Stubbs Alderton & Markiles, LLP (Sherman Oaks)*

Joshua Hofheimer, Sidley Austin Brown & Wood LLP (Los Angeles)

Michael Plumleigh, Critical Path, Inc. (San Francisco)

9:15a.m. – 9:30a.m.

Break

9:30a.m. – 10:30a.m. (1 Hour MCLE Credit)

TRACK I – PATENTS

Thinking Outside the Box—A Case Study for Defeating the Patent Trolls The argument can be made that “patent trolls” are good for the patent system or that they are bad for the patent system. But, no matter how they are viewed by the public, they have become more sophisticated and aggressive in filing patent infringement actions against corporations. This Program will address some of the issues to consider when dealing with a “patent troll,” as well as a number of litigation strategies that have been used to defeat them.

Speaker: *Stephen S. Korniczky, Paul, Hastings, Janofsky & Walker, LLP (San Diego)*

9:30a.m. – 10:45a.m. (1.25 Hour MCLE Credit)

TRACK II – MIXED

Trademark Year in Review

The panelists, a well-known professor and an expert in the field of trademark law, will be presenting an overview of the recent developments in trademark law and the foreseeable impact of these developments.

Moderator: *Warren Dranit, Spaulding McCullough & Tansil LLP (Santa Rosa)*

Panelists: *David J. Franklyn, University of San Francisco School of Law (San Francisco)*

Tsan Abrahamson, Cobalt LLP (Berkeley)

10:30a.m. – 12:00 noon (1.5 Hour MCLE Credit)

TRACK I – PATENTS

In the Wake of *Phillips v. AWH*: The Aftermath and a Debate Over *DeNovo* Appellate Review

Phillips v. AWH established clearer guidelines for claims construction, sending the case back to the district court for trial, which occurred this year. Few know that a petition for writ of certiorari had been filed on the basis of the Federal Circuit’s *en banc* de novo review of the district court’s *Markman* ruling. Although denied by the Supreme Court, the issue will likely come up again. Robert Payne, trial counsel and counsel before the Supreme Court for plaintiff Edward Phillips will discuss the post-appellate trial developments in the *Phillips* case. Frank Bernstein, amicus brief writer before the Federal Circuit, will discuss *Phillips* impact in later cases. The two will then debate the issue of appellate *de novo* review.

Panelists: *Robert Payne, LaRiviere Grubman & Payne (Monterey)*

Frank Bernstein, Kenyon & Kenyon LLP (San Jose)

10:45a.m. – 12:00noon (1.25 Hour MCLE Credit)

TRACK II – MIXED

The Medium is the Message: How New Media Technologies Will Transform Copyright Protection and Limits Broadband, ITV, IPTV, WiFi, and VoIP and are just some of the new media technologies providing innovative means for distribution of content. But with these opportunities come new challenges for copyright owners to protect, license, exploit and enforce their content. The speakers will explore these emerging issues and how they will impact content owners and technology providers. In this dynamic presentation, they will 1) provide an overview of the hottest new media technologies; 2) explore copyright issues raised by mobile devices and technologies; 3) discuss intellectual property and business issues in interactive user environments (such as gaming, the Google Video service, and social networking sites); 4) examine digital rights management issues raised by new media technologies; and 5) consider the impact on existing content distribution systems of technologies that provide the consumer with direct access and choice.

Panelists: *James Nguyen, Foley & Lardner, LLP (Los Angeles)*

Carole Handler, Foley & Lardner, LLP (Los Angeles)

12:00 noon – 1:15p.m.

Standing Committee Luncheon Meetings

Each Standing Committee meeting listed below is open to any Institute attendee. Please select the committee luncheon you wish to attend by checking the appropriate box on the registration form.

Computer Law

Copyright Law

Diversity

Licensing

New Matter

Patent Law

Trade Secret Law

Trademark Law

1:15p.m. – 1:30p.m.

Break

1:30p.m. – 2:30p.m. (1 Hour Substance Abuse)

GENERAL SESSION

Sex, Drugs and Rock & Roll—A Short Primer on Substance Abuse

Carol M. Langford, a nationally recognized expert in IP law, ethics, and substance abuse will speak on the issue of substance abuse in the legal profession and provide attendees with that hard to gain MCLE credit in an entertaining yet informative fashion.

Speaker: *Carol Langford, Attorney at Law (Walnut Creek)*

2:30 – 4:00p.m.

It's a Wrap!

Post Production beer and wine party *Sponsored by Fish & Richardson*

Conference Adjourns

The Intellectual Property Section welcomes all who are interested in Intellectual Property. You need not be a lawyer to attend, enjoy and benefit from this program.

REGISTRATION FEES:

Registration fees include admission to 15.25 hours of MCLE instruction, (which includes 1 hour Substance Abuse and 1 hour Elimination of Bias in the legal profession) course materials, continental breakfasts, luncheons and the evening receptions.

THREE WAYS TO REGISTER:

Registration deadline: October 27, 2006

Online: Register online by visiting www.calbar.ca.gov/ipsection

Fax: You may fax your registration form to Program registrations at (415) 538-2368. All faxed registrations must be accompanied by a signature and MasterCard or VISA card number.

Mail: Mail registration form and check made payable to the State Bar of California or credit card information to: Program Registrations, The State Bar of California, 180 Howard Street, San Francisco, CA 94105.

CANCELLATIONS:

All requests for refunds must be received in writing no later than October 27, 2006. Refunds will be issued less a \$50 non-refundable administrative cost. Refunds will not be available after the October 27th deadline, however, registrations substitutions are welcome.

SPECIAL ASSISTANCE:

Please call (415) 538-2585 for special assistance or TDD (415) 538-2231 for speech and hearing impaired.

HOTEL RESERVATIONS AT FESS PARKER'S DOUBLETREE RESORT:

We have reserved a limited block of sleeping rooms at Fess Parker's DoubleTree Resort in Santa Barbara. Please contact the hotel directly at (805) 564-4333 to make your reservation. Please identify yourself as part of the State Bar of California Intellectual Property Institute to obtain the special rate of \$195 single/double plus occupancy tax per night. Please make your reservation by **October 11, 2006**. Reservations made after the **October 11, 2006** deadline will be made on a space available basis at the confirmed group rate.

INFORMATION:

For more information, please call the Intellectual Property Section at (415) 538-2375.
For registration information, please call program registrations at (415) 538-2508.

REGISTRATION DEADLINE: OCTOBER 27, 2006

Three Ways to Register!

Online: Register online by visiting
www.calbar.ca.gov/ipsection

Fax: You may fax your registration form to Program registrations at (415) 538-2368. All faxed registrations must be accompanied by a signature and MasterCard or VISA card number.

Mail: Mail registration form and check made payable to the State Bar of California or credit card information to: Program Registrations, The State Bar of California, 180 Howard Street, San Francisco, CA 94105.

Note: One registrant per form. Photocopies may be used

Bar Number: _____

Name: _____

Firm Name: _____

Firm Address: _____

City, State & Zip: _____

Phone: _____

Fax: _____

E-mail: _____

(required for e-mail confirmation)

Guest: _____

(Note: if your guest does not fall within a registration fee category, then registration is complimentary. All others must complete a separate registration form and pay the appropriate registration fee.)

- ☐ Check here if you do not want your information released to other IP Institute attendees and exhibitors/vendors.

Registration Fees (*check the appropriate box*):

- ☐ \$495 – IP Section Members
☐ \$595 – Non-Members of the Intellectual Property Section (*includes enrollment in the Intellectual Property Law Section for 2007*)
☐ \$295 – Law School Faculty and new bar admittees
☐ \$150 – Students and Paralegals

Subtotal of Registration Fee \$ _____

Special Events:

Friday Luncheon (*free for PAID registrants*)

☐ I will attend FREE
Number of Guests - Friday Luncheon
_____ @ \$35 = \$ _____

Friday Wine Tasting Reception & Dinner

_____ @ \$60 = \$ _____

Saturday Committee Luncheon

☐ I will attend FREE
(indicate which Committee luncheon you will attend)

- | | |
|--|---------------------------------------|
| <input type="checkbox"/> Copyright Law | <input type="checkbox"/> New Matter |
| <input type="checkbox"/> Computer Law | <input type="checkbox"/> Patent Law |
| <input type="checkbox"/> Diversity | <input type="checkbox"/> Trademark |
| <input type="checkbox"/> Licensing | <input type="checkbox"/> Trade Secret |

Saturday Reception

☐ I will attend FREE

Subtotal of Special Events Fee \$ _____

Total Amount Enclosed or to be charged \$ _____

Payment Method:

Registration fees may be paid by check, VISA or MasterCard. No other credit cards will be accepted. Make checks payable to the State Bar of California.

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REGISTRATION FORM



31ST ANNUAL INTELLECTUAL PROPERTY INSTITUTE

November 3-4, 2006

Bonus Session:

**Nuts & Bolts Program on
November 2, 2006**

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